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| 10/730,117   | 12/09/2003  | Sugio Makishima      | 2091-0304P          | 4321             |
| 2292 7590 01/05/2010<br>BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      |                     |                  |
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| BEMBEN, RICHARD M  |             |                      |                     |                  |
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## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, clearly defining the disputed claim language, (see pages 3-4 of Applicant's Remarks filed 8 December 2009), with respect to 35 USC 112, first paragraph rejection (see Supplemental Final Rejection dated 9 September 2009) have been fully considered and are persuasive. The 35 USC 112, first paragraph rejection of claims 1 and 9 has been withdrawn.

2. Applicant's arguments with respect to the 35 USC 102(e) rejections of claims 1 and 9 have been fully considered but they are not persuasive. Claims 1 and 9 require, *inter alia*, that images with printing-specifying information and images without printing-specifying information are displayed in such a way as to be discriminated from each other "prior to the digital image being read out of the digital camera for printing".

Applicant argues that the examiner has not established a *prima facie* case of anticipation because Kawamura (US Patent No. 6,522,354) does not disclose the claim limitation "prior to the digital image being read out of the digital camera from printing".

Examiner disagrees. In rejecting this limitation, the examiner cited to col. 9, ll. 50-60 of Kawamura, which discloses two options for displaying printing-specifying information (i.e. icons): "[1] the same number of icons as the number of transfers may be displayed, or [2] number of transfers may be displayed in the middle of the corresponding icon".

Applicant's arguments focus on the first option [1]. However, at page 6 in the previous office action (Supplemental Final Rejection dated 9 September 2009), the examiner explicitly relied upon the second option [2], explaining:

Refer to c. 9, II. 50-60; in the situation where the recorded information is to be transferred to external equipment a plurality of times, "the number of transfers may be displayed in the middle of the corresponding icon" and "the operator is informed of the number of transfers of the recorded information". Therefore, whether the number of transfers is displayed in the middle of the icon before all of the transfers or whether the number is updated as the transfers complete, the icon is displayed prior to recorded information (image data) being read out of the storage medium for printing[.]

In the situation where number of transfers (i.e. number of prints) is displayed in the middle of the icon before all of the transfers, the icon is present prior to printing to discriminate images with printing-specifying information from images without printing-specifying information. In the situation where the number of transfers in the middle of the icon is updated, the icon is still present prior to printing to discriminate images with printing-specifying information from images without printing-specifying information.

Thus, Kawamura anticipates claims 1 and 9.

3. Applicant's arguments with respect to the 35 USC 103(a) rejections of claims 2, 6, 7, 10 and 11 have been fully considered but they are not persuasive. Examiner notes that Honda (US Pub. No. 2004/0201764) was not relied on to teach "displaying digital image data of a number of thumbnail images at the same time in the camera display" or "displaying images for which printing-specifying information was set and digital image data with no printing-specifying information so they may be discriminated from each other when they are displayed on said displaying means prior to the digital image data being read out of the storage medium for printing". As discussed *supra*, Kawamura was relied on to teach and does teach these features.
4. Applicant's arguments with respect to the 35 USC 103(a) rejections of claims 4/1 and 8 have been fully considered but they are not persuasive. Applicant argues that

Hanzawa (U.S. Patent No. 5,506,661) is not in the same field of endeavor as Kawamura and thus the combination of Kawamura and Hanzawa is invalid. However, the Supreme Court explicitly stated in *KSR* that "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007); MPEP 2141 [R-6]. Therefore, the combination of Kawamura and Hanzawa is not barred simply because Kawamura is directed to a digital camera and Hanzawa is directed to a display for a mimeographic apparatus. Further note that Kawamura discloses a display and Hanzawa is relied on for certain display features/functionality, i.e. the nexus that applicant seeks.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHARD M. BEMBEN whose telephone number is (571)272-7634. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ometz David can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMB

**/Justin P Misleh/  
Primary Examiner, Art Unit 2622**